

Application No. 10/020,048

Filed: 12/14/2001

Attorney Docket No. DE920000125US1 (7161-210U)

REMARKS

At the time of the Office Action dated October 6, 2005, claims 1-17 were pending and rejected in this application.

CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 2 and 3 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-17, is directed to non-statutory subject matter. This rejection is respectfully traversed.

Applicants note that subsequent to the issuance of the Office Action, a precedential opinion has been issued by the Board of Patent Appeals and Interferences (hereinafter the Board) addressing issues associated with 35 U.S.C. § 101. In Ex parte Lundgren¹, the Board stated, in part, that "there is no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." Applicants position is that, based upon the decision in Ex parte Lundgren, the Examiner has failed to establish that the claimed invention, as recited in claims 1-17, is directed to non-statutory subject matter. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-17 under 35 U.S.C. § 101.

CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
SORGE ET AL., U.S. PATENT NO. 6,613,098 (HEREINAFTER SORGE), IN VIEW OF CHAU ET AL.,
U.S. PATENT NO. 6,721,727 (HEREINAFTER CHAU)

On pages 3-6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Sorge in view of Chau to arrive at the claimed invention. This rejection is respectfully traversed.

¹ Appeal No. 2003-2088.

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Although Applicants disagree that the claimed invention is obvious based upon Sorge in view of Chau, to expedite prosecution of the Application, Applicants submit that the reference to Chau cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(I).

**Application No. 10/020,048 (the present application) and
U.S. Patent No. 6,721,727 (Chau) were, at the time the invention
was made, commonly owned by International Business Machines
Corporation**

Thus, under 35 U.S.C. § 103(c), the reference to Chau cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Applicants, therefore, respectfully submit that the imposed rejection of claims 1-17 under 35 U.S.C. § 103 for obviousness based upon Sorge in view of Chau is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

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remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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